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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,345	08/31/2000	David H. Farb	0146-2026	2909

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FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER	
LI, RUIXIANG	
ART UNIT	PAPER NUMBER
1646	24

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/652,345	Applicant(s) FARB ET AL.	
	Examiner Ruixiang Li	Art Unit 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): *claim 59 under 35 USC 112, 2nd paragraph..*

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet.*

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: *10*.

   Claim(s) rejected: *1-9,11,26-29,32,33 and 58-65*.

   Claim(s) withdrawn from consideration: _____.

8. ☒ The proposed drawing correction filed on *18 November 2002* is a)☒ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: the rejection of claims 1-9, 11, 26-29, 32, 33, and 58-65 under 35 USC 103 (a), as set forth in the previous office action (Paper No. 19, June 10, 2002), remains.

Applicants argue (i) that the Examiner has used impermissible hindsight to pick and choose different elements of as many as five different pieces of prior art to come up with the claimed methods (1st paragraph of page 3); and (ii) the reference by Dagget neither provides a specific motivation to arrive at the elements of claim 1 in combination , nor provides a reasonable expectation of success (2nd paragraph of page 3).

This has been fully considered but is not deemed to be persuasive for the following reasons.

First, the primary refernce by Park-Chung et al. teaches a general method of identifying subunit specific steroid modulators of the N-methyl-D-aspartate (NMDA) receptor. While Park-Chung et al. fail to teach providing a plurality of recombinant NMDA receptors which differ in their subunit identity" and NMDA receptors with various mutations, the art clearly teach all these NMDA receptors and various mutations. The Examiner notes that while five references are used in the 103 (a) rejection, each art is used against a specific number of claims; not all five references are used aginast a single claim. In retrospect, the 103 (a) could have been split into five 103(a) rejections where the primary reference by Park-chung et al. and only one secondary refernce are used.

Secondly, the motivation to combine the teaching of Park-Chung et al. is clearly taught in the art. That is, determination of the effect of the drug substances on specific receptor subunits or mutations should permit development and screening receptor subtype-specific or disease-specific drugs and reduction of unwanted side effects, as suggested by Daggett et al. (U.S. Patent number 5,849,895, 12/15/1998, column 15, 4th and 5th paragraphs) and the expression of recombinant NMDA receptors in, e.g., Xenopus oocytes, provides an ideal approach to examine the biological functions of the NMDA receptors and to evaluate the effect of modulators on the NMDA receptors, as demonstrated in the cited references. It is unnecessary that the claimed invention be expressly suggested in any one or all of the references to justify combining their teachings; rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art In re Keller, 642 F.2d 413, 288 USPQ 871 9ccpa 1981).

Elyabeth C. Kemmerer